



3510-16-P

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Proposed Collection; comment request; “Third-Party Submissions and Protests”

AGENCY: United States Patent and Trademark Office, Commerce

ACTION: Notice

SUMMARY: The United States Patent and Trademark Office (USPTO), as part of its continuing effort to reduce paperwork and respondent burden, invites the general public and other Federal agencies to comment on proposed and/or continuing information collections, as required by the Paperwork Reduction Act of 1995, Public Law 104–13 (44 U.S.C. 3506(c)(2)(A)).

DATES: Written comments must be submitted on or before *{insert date 60 days after the date of publication in the Federal Register, in the format “month, day, year”}*.

ADDRESSES: Written comments may be submitted by any of the following methods:

- *Email:* InformationCollection@uspto.gov. Include “0651-0062 Third-Party Submissions and Protests” in the subject line of the message.
- *Mail:* Marcie Lovett, Records Management Division Director, Office of the Chief Information Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313–1450.
- *Federal Rulemaking Portal:* <http://www.regulations.gov>.

FOR FURTHER INFORMATION CONTACT: Requests for additional information should be directed to Raul Tamayo, Senior Legal Advisor, Office of Patent Legal Administration, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450; by telephone at 571-272-7728; or by e-mail to Raul.Tamayo@uspto.gov with “Paperwork” in the subject line. Additional information about this collection is also available at <http://www.reginfo.gov> under “Information Collection Review.”

SUPPLEMENTARY INFORMATION:

I. Abstract

The United States Patent and Trademark Office (USPTO) is required by 35 U.S.C. § 131 *et seq.* to examine an application for patent and, when appropriate, issue a patent. The provisions of 35 U.S.C. §§ 122(c), 122(e), 131, and 151, as well as 37 CFR 1.290 and 1.291, limit the ability of a third party to have information entered and considered in, or to protest, a patent application pending before the Office.

37 CFR 1.290 provides a mechanism for third parties to submit to the USPTO, for consideration and inclusion in the record of a patent application, any patents,

published patent applications, or other printed publications of potential relevance to the examination of the application.

A preissuance submission under 37 CFR 1.290 may be made in any non-provisional utility, design, and plant application, as well as in any continuing application. A preissuance submission under 37 CFR 1.290 must include a concise description of the asserted relevance of each document submitted, and must be submitted within a certain statutorily specified time period.

37 CFR 1.291 permits a member of the public to file a protest against a pending application. Protests pursuant to 37 CFR 1.291 are supported by a separate statutory provision from third-party submissions under 37 CFR 1.290 (35 U.S.C. 122(c) v. 35 U.S.C. 122(e)). As a result, there are several differences between protests and third-party submissions.

For example, 37 CFR 1.291 permits the submission of information that is not permitted in a third-party submission under 37 CFR 1.290. Specifically, 37 CFR 1.291 provides for the submission of information other than publications, including any facts or information adverse to patentability, and arguments to that effect. Further, 37 CFR 1.291 requires a protest to include a concise explanation of the relevance of each item of information submitted. Unlike the concise description of relevance required for a preissuance submission under 37 CFR 1.290, which is limited to a description of a document's relevance, the concise explanation for a protest under 37 CFR 1.291 allows for arguments against patentability. Additionally, the specified time period for submitting a protest differs from the time period for submitting third-party submissions, and is impacted by whether the protest is accompanied by the written consent of the applicant.

This information collection (the information collected via third-party submissions under 37 CFR 1.290 and protests under 37 CFR 1.291) is necessary so that the public may contribute to the quality of issued patents. The USPTO will use this information, as appropriate, during the patent examination process to assist in evaluating the patent application.

II. Method of Collection

Electronically when using the USPTO online filing system EFS-Web, or by mail or hand delivery.

III. Data

OMB Number: 0651–0062.

IC Instruments: The individual instruments in this collection, as well as their associated forms, are listed in the table below.

Table 1: Information Collection Instruments and Forms

IC Number	Information Collection Instrument	Form Number
1	Third-Party Submissions in Nonissued Application; electronic	<ul style="list-style-type: none">No Form Associated
2	Third-Party Submissions in Nonissued Application; paper	<ul style="list-style-type: none">PTO/SB/429
3	Protests by the Public Against Pending Applications Under 37 CFR 1.291; paper	<ul style="list-style-type: none">No Form Associated

Type of Review: Revision of a currently approved collection.

Affected Public: Individuals or households; businesses or other for-profits; and not-for-profit institutions.

Estimated Number of Respondents: 1,560 responses per year.

Estimated Time per Response: The USPTO estimates that it will take the public approximately 10 hours to gather the necessary information, prepare the appropriate form or other documents, and submit the information to the USPTO.

Estimated Total Annual Hour Burden: 15,600 hours.

Estimated Total Annual Cost Burden (Hourly): \$6,068,400. The USPTO expects that attorneys will complete the instruments associated with this information collection. The professional hourly rate for an attorney is \$389. Using this hourly rate, the USPTO estimates \$6,068,400 per year for the total hourly costs associated with respondents.

Table 2: Hourly Cost Burden

IC Number	Information Collection Instrument	Estimated time for response (minutes) (a)	Estimated Annual Responses (b)	Estimated annual burden hours (a) x (b) = (c)	Rate (\$/hr) (d)	Total Cost (\$/hr) (c) x (d) (e)
1	Third-Party Submissions in Nonissued Applications (electronic)	10 hours	1,500	15,000	\$389.00	\$5,835,000.00
2	Third-Party Submissions in Nonissued Applications (paper)	10 hours	50	500	\$389.00	\$194,500.00
3	Protests by the Public Against Pending Applications Under 37 CFR 1.291 (paper)	10 hours	10	100	\$389.00	\$38,900.00
Totals	1,560	15,600	\$6,068,400.00

Estimated Total Annual Cost Burden (Non-Hourly): \$237,619.25 per year. There are no capital start-up, recordkeeping or maintenance costs associated with this information collection. There are, however, annual (non-hour) costs associated with this information collection in the form of filing fees and postage costs.

When submitting the information in this collection to the USPTO electronically, the applicant is strongly urged to retain a copy of the file submitted to the USPTO as

evidence of authenticity in addition to keeping the acknowledgment receipt as clear evidence of the date the file was received by the USPTO. The USPTO does not, however, require this recordkeeping, and thus does not consider this action to be a recordkeeping cost imposed on the applicant.

This collection has a non-hourly annual cost burden in the form of filing fees. 37 CFR 1.290 requires the payment of the fee set forth in 37 CFR 1.17(o) for every ten documents, or fraction thereof, listed in each third-party preissuance submission. The USPTO provides an exemption from this fee requirement where a preissuance submission listing three or fewer total documents is the first preissuance submission submitted in an application by a third party, or a party in privity with the third party. Taking the fee and exemption into account, the USPTO estimates that the average fee per submission for the third-party submissions is \$180, with the average fee for small entities totaling \$90.

There is no fee for filing protests under 37 CFR 1.291 unless the filed protest is the second or subsequent protest by the same real party in interest, in which case the 37 CFR 1.17(i) fee of \$130 must be included (the USPTO estimates 1 of the 10 protests filed per year will trigger this fee). The table below illustrates the total amount of and distribution of filing fees associated with this collection.

Table 3: Non-Hourly Cost Burden – Filing Fees

IC Number	Information Collection Instrument	Responses (yr) (a)	Filing fee (\$) (b)	Total non-hour cost burden (yr) (a) x (b) = (c)
1-2	Third-Party Submissions in Nonissued Applications	1,085	\$180	\$195,300.00

IC Number	Information Collection Instrument	Responses (yr) (a)	Filing fee (\$) (b)	Total non-hour cost burden (yr) (a) x (b) = (c)
1-2	Third-Party Submissions in Nonissued Applications (small entity)	465	\$90	\$41,850.00
3	Protests by the public against pending applications under 37 CFR 1.291	1	\$130	\$130.00
Total	1,551	\$237,280.00

This collection also has a non-hourly annual cost burden in the form of postage costs. Customers may incur postage costs when submitting the Information Collection instruments contained within this collection to the USPTO by mail through the United States Postal Service. The USPTO estimates that the average first class postage cost for a one-pound submission mailed in a flat-rate envelope to be \$5.75. The USPTO further estimates that the vast majority—roughly 98 percent—of all paper submissions will be delivered by mail, with the remainder delivered by hand delivery, for an estimate that approximately 59 submissions will require postage. Therefore, the estimated postage cost for this collection will be \$339.25.

The total non-hour respondent cost burden for this collection in the form of filing fees (\$237,280) and postage costs (\$339.25) is approximately \$237,619.25 per year

IV. Request for Comments

Comments are invited on: (a) Whether the proposed collection of information is necessary for the proper performance of the functions of the agency, including whether the information shall have practical utility; (b) the accuracy of the agency's estimate of the burden (including hours and cost) of the proposed collection of information, including the validity of the methodology and assumptions used; (c) ways to enhance

the quality, utility, and clarity of the information to be collected; and (d) ways to minimize the burden of the collection of information on respondents, including through the use of automated collection techniques or other forms of information technology, e.g., permitting electronic submission of responses.

Comments submitted in response to this notice will be summarized or included in the request for OMB approval of this information collection; they will also become a matter of public record.

Dated: March 9, 2015

Marcie Lovett

Records Management Division Director, USPTO

Office of the Chief Information Officer.

BILLING CODE 3510-16-P

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